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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,330	05/11/2001	Eric Yang	15448-0501	7662

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HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,330

Applicant(s)

YANG ET AL.

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on May 11, 2001.

Claims 1-78 are currently pending.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on August 6, 2001 is being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-39 only recite an abstract idea. The recited steps of merely receiving an inquiry, access the information, determining a licensing amount, updating a parameter and allowing an item to be used does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to manage multiple contracts. There is not technology recited in the body of the claims.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "a computer implemented method". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-27, 31-66, and 70-78 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al (US 2004/0133793) (hereinafter referred to as Ginter).

Referring to Claims 1 and 40:

Ginter discloses a computer implemented method and medium for managing multiple contracts ([0012] electronic contract), comprising:

receiving an inquiry ([0012] electronic contract, [0053], [0078-0081] Electronic content, [0093], [0161-0162], Figures 72A-72D, [0137];

accessing information comprising a set of one or more associated contract terms pertaining to the plurality of contracts ([0058], [0061- 0067], [0078], [0093], [0107])

determining a plurality of contracts that are implicated by the inquiry ([0161-0166])

processing the inquiry based upon one or more applicable contract terms ([0161-0163], 0247));

Referring to Claims 10 and 49:

Ginter discloses a computer implemented method and medium for managing multiple contracts ([0012] electronic contract), comprising:

receiving a first inquiry regarding a first resource under a particular contract ([0012] electronic contract, [0053], [0078-0081] electronic content, [0093], [0161-0162], Figures 72A-72D, [0137]);

accessing information pertaining to the contract, the information comprising quota parameter which specifies a quota of resources that can be consumed under the contract, and one or more contract terms associated with the contract ([0161-0162], [0166] metering the number of copies, Figures 3 and 4, [0426-0433]);

determining a first amount attributable to obtaining the first resource by applying one or more of the contract terms ([0012], [0405] how much it costs to use the content, [0410-0411] specify how much it costs, [0426-0431]; Figure 26A (944) number of rights record; Figure 50d (1718));

updating the quota parameter based upon the first amount (Figure 61 (2239) update Meter, [0393]); and

allowing the first resource to be used under the contract ([0062] Figure 3 (402) GO).

Referring to Claims 31-33 and 70-72:

Ginter discloses a computer implemented method and medium for managing multiple contracts ([0012] electronic contract), comprising:

receiving a first inquiry regarding obtaining a first resource under a particular contract ([0012] electronic contract, [0053], [0078-0081] electronic content, [0093],[0161-0162], Figures 72A-72D, [0137];

accessing information pertaining to the contract, the information comprising quota parameter which specifies a quota of resources that can be consumed under the contract, and one or more contract terms associated with the contract ([0161-0162] parameters, [0166] metering the number of copies, Figures 3 and 4, [0214], [0426-0433]);

accessing one or more other sets of information pertaining to one or more contract terms pertaining to one or more other contracts related to the contract ([0012] and [0161-0162], Figures 3-4, [0061] [0077-0081];

processing the information to derive one or more applicable contract terms that apply to the inquiry by reconciling the information to extract the applicable contract terms [0163-0165];

determining a first amount attributable to obtaining the first resource by applying one or more of the contract terms ([0012], [0405] how much it costs to use the content, [0410-0411 specify how much it costs, [0426-0431]; Figure 26A (944) number of rights record; Figure 50d (1718);

updating the quota parameter based upon the first amount (Figure 61 (2239) update Meter, [0393]); and
allowing the first set of software to be used under the contract ([0062] Figure 3 (402) GO).

Referring to Claims 2, 9, 41 and 48:

Ginter discloses wherein processing and reconciling comprises:
processing each of the plurality of contracts in a particular order ([0163-0165]);
determining whether the contract has a contract term that applies to the inquiry ([0163-0165], [0247]);
upon finding a contract term, including the term as one of the one or more applicable contract terms ([0161-0165]).

Referring to Claims 3 and 42:

Ginter discloses determining which particular contract is being invoked by the inquiry and determining at least one other contract that is related to the particular contract ([0248-0273]).

Referring to Claims 4 and 43:

Ginter discloses wherein the particular contract and the other contract are related to each other through a hierarchy ([0249-0255]).

Referring to Claims 5 and 44:

Ginter discloses determining whether a set of contract terms associated with a particular contract comprises a contract term that applies to the inquiry; and
in response to the determination that terms do not apply, determining whether the terms of the other contract applies to the inquiry ([0239], [1112]).

Referring to Claims 6 and 45:

Ginter discloses in response to a determination that the set of contract terms associated with the particular contract do apply, including the contract term as one of the one or more applicable contract terms ([0163-0164]).

Referring to Claims 7 and 46:

Ginter discloses in response to a determination that the set of contract terms associated with the other contract does apply, including the term in the one or more applicable contract terms ([0163-0164]).

Referring to Claims 8 and 47:

Ginter discloses wherein the contract terms associated with a particular one of the plurality of contracts may differ from the contract terms associated with another of the plurality of contracts, and wherein processing the information comprises reconciling the terms to derive one or more applicable contract terms ([0161-0165]).

Referring to Claims 11-15 and 50-54:

Ginter discloses wherein the first resource comprises a product, a service, a license to a set of property, wherein the property comprises intellectual property or proprietary information ([0025-0030], [0046-0053], [0071]).

Referring to Claims 16-19 and 55-58:

Ginter discloses wherein the one or more contract terms comprises an uplift, a discount, a multiplier or an additional resource to be included with the first resource ([0174], [0186-0190]).

Referring to Claims 20 and 59:

Ginter discloses Receiving a second inquiry regarding obtaining a second resource under the particular contract ([0025], [0046-0052], [0071], [0093], [0161-0162], [0174]);

accessing the information pertaining to the particular contract ([0161-0162], Figures 3 and 4 [0214], [0426-0433]);

determining a second amount attributable to obtaining the second resource by applying one or more contract terms ([0012] [0405], [0410-0411], [0426-0431], Figure 26A (944), Figure 50d(1718));

updating the quota parameter based on the second amount (Figure 61 (2239) [0393]); and

allowing the second resource to be obtained under the contract ([0062] Figure 3 (404) GO).

Referring to Claims 21 and 60:

Ginter discloses wherein the second resource is of a different type than the first resource ([0012], [0061], [0107], [0161])

Referring to Claims 22 and 61:

Ginter discloses herein the one or more contract terms applied to determine the first amount are different from the one or more contract terms applied to determine the second amount ([0161-0165]).

Referring to Claims 23 and 62:

Ginter discloses wherein the one or more contract terms applied to determine the first amount are the same as the one or more contract terms applied to determine the second amount ([0161-0165]).

Referring to Claims 24 and 63:

Ginter discloses reducing the quota parameter by the first amount (Figure 61 (2239), [0393], [0161]).

Referring to Claims 25 and 64:

Ginter discloses wherein the first inquiry specifies one or more additional inquiry parameters and wherein the first amount is determined based upon at least one or more additional inquiry parameters (Figure 72A-72D).

Referring to Claims 26 and 65:

Ginter discloses wherein at least one or the one or more additional inquiry parameters is specifiable by a sender of the inquiry (Figure 72A-72D).

Referring to Claims 27 and 66:

Ginter discloses determining, using additional inquiry parameters, which of the one or more contract terms apply to the first inquiry ([0161-0165]).

Referring to Claims 34-35, 37-39, 73-74, and 76-78:

Ginter discloses processing the set of information in a particular order, searching as each set is processed for contract terms that apply and finding a contract term that applies ([0161-0165])

Referring to Claims 36 and 75:

Ginter discloses, in response to a determination that the information does not comprise a contract term that applies, deriving the one or more applicable contract terms from other sets (0161-0165])

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 28-30 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter.

Referring to Claims 28-30 and 67-69:

Ginter discloses a computer-implemented method for managing multiple contract ([0012] electronic contract). Ginter discloses usage auditing, reporting, and payment [0078].

Ginter does not disclose determining a refund amount and updating the quota parameter based upon the refund.

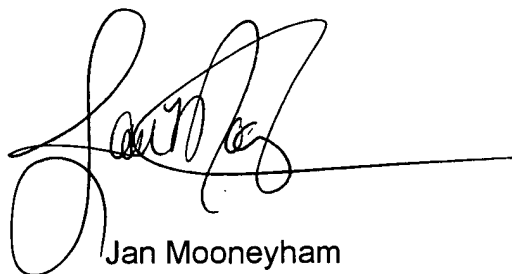
However, it would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Ginter a refund mechanism since it makes good business sense to provide a credit for unused portions so as to maintain customer satisfaction and loyalty.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Jan Mooneyham', with a long horizontal line extending to the right.

Jan Mooneyham
Patent Examiner
Art Unit 3629